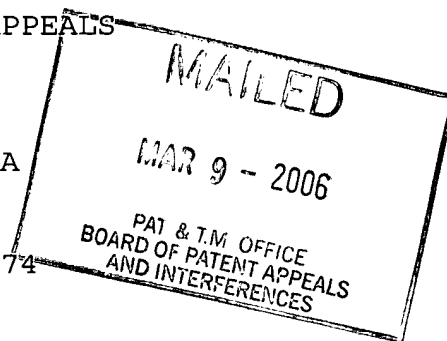


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASATO FUJINAGA

Application No. 09/977,274



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on February 10, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

On October 16, 2001, an Information Disclosure Statement (IDS) was filed. A review of the Image File Wrapper reveals that the examiner has not considered the IDS. MPEP § 609 states, in part:

" . . . The Examiner must also fill in his or her name and the date the information was considered in blocks at the bottom of the PTO-1449 or PTO/SB/08A and 08B form."

On February 10, 2005, appellant filed Appeal Brief. A review of the file indicates that the Appeal Brief does not fully comply with 37 CFR § 41.37(c).

37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

A review of the application indicates that the following sections are missing from the Appeal Brief of February 10, 2005:

- 1) "Evidence appendix" as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 2) "Related proceedings appendix" as set forth in 37 CFR § 41.37(c)(1)(x).

Accordingly, the Appeal Brief filed on February 10, 2005 does not comply with the new rules under 37 CFR § 41.37(c). It is required that a substitute brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

On August 4, 2005, appellant filed Amendment under 37 CFR § 1.116. There is no indication in the record that the Amendment under 37 CFR § 1.116 has been considered.

Accordingly, it is

ORDERED that the application is returned to the Examiner for resolution of the following issues:

- 1) consideration of the IDS, written notification to the applicant of such consideration;
- 2) hold the Appeal Brief of February 10, 2005 defective;
- 3) to notify appellant to file a substitute appeal brief in compliance with 37 CFR § 41.37;
- 4) for the examiner to consider the substitute appeal brief, vacate the Examiner's Answer June 8, 2005, and issue a revised Examiner's Answer in accordance with the new rules effective September 13, 2004;

5) consideration of the Amendment under 37 CFR § 1.116 filed August 5, 2005; and

6) for further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

DALE M. SHAW

Program and Resource Administrator
(571) 272-9797

DMS/dal

MCDERMOTT, WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096